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In re Application of :
Matsuda et al. :
Application No. 10/024,298 :
Filed: December 21, 2001 :
Attorney Docket Number: :
1254-0191P

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OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition filed August 23, 2002, requesting that the above-identified application be accorded a filing date of December 21, 2001.

The petition is granted.

The application was deposited on December 21, 2001. However, on February 21, 2002, the Office mailed a "Notice to File Missing Parts of Nonprovisional Application" stating that the application had been accorded a filing date of December 21, 2001, and advising applicants that the oath or declaration, small entity fee, and an English language translation and fee were required. Subsequent review of the application revealed that the application had been filed without drawings, and that a sequence listing, a paper copy or compact disk copy thereof, and an amendment directing entry of the sequence listing into the application were required. On June 6, 2002, the Notice to File Missing Parts of Nonprovisional Application was withdrawn, and a Notice of Incomplete Nonprovisional Application, noting the missing drawings and sequence listing, was mailed.

Petitioner responds with the instant petition wherein Petitioner avers that the drawings and at least some of the sequences in the above-identified application were incorporated by reference to prior provisional application.

Initially it is noted that a review of the file reveals that the specification contains both process claims (i.e., claims 11, 12, 14 and 17), and method claims (i.e., claims 13, 20, 23, and 27). As stated in MPEP § 601.01(f), it is the practice of the PTO to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

Application No. 10/024,298

MPEP § 601.01(f) also states that:

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

This application contains both process and method claims. Therefore, the application should have been treated as an application for which a drawing is not necessary for an understanding of the invention.

Regarding the drawings, MPEP § 601.01(g) states that if an application is filed without all of the drawing figure(s) referred to in the specification, a "Notice of Omitted Item(s)" is mailed indicating that the application has been accorded a filing date, but is lacking some of the figures of drawings described in the specification.

Applicants are advised that a petition is not necessary in this instance to add the drawing figures. Applicants may add figure(s) described in the specification on the basis that the drawings are not new matter. New drawings may be entered by the primary examiner without a petition so long as the drawings contain no new matter. See, MPEP § 608.02(a).

Moreover, the sequence listing, 37 CFR 1.821(g) provides that where an application disclosing sequences is filed without a copy of the sequence listing and a compact disk copy, "applicant will be notified and given a period of time within which to comply with such requirements in order to prevent abandonment of the application". Moreover, nonessential matter may be incorporated by reference. See MPEP 608.01(I).

MPEP 201.06(c) states:

. . . an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such

Application No. 10/024,298

specifically enumerated prior application or applications are "hereby incorporated by herein by reference." The statement may appear in the specification or in the application transmittal letter The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. (emphasis supplied).

In view of the above, the requirement to submit drawings was sent in error. The "Notice" mailed June 6, 2002, is hereby vacated with regards to the requirement to submit drawings.

This application is being forwarded to the Office of Initial Patent Examination, Customer Corrections, for further processing, with the filing date of December 21, 2001, and an indication that no drawings were required at filing, and that no sequence listing and a compact disk copy were present on filing.

No petition fee is required and a refund of the petition fee has been credited to Petitioner's deposit account as authorized in the instant petition.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.

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